

## **REMARKS**

### **Summary of Amendments to the Claims**

1. Claim 12 has been amended as suggested by the Examiner to address an informality. The dependency of claim 12 has been changed from “claim 6” to “claim 11.”

### **Response to Items in “Detailed Action”**

The following comments are submitted in response to the items set forth in the “Detailed Action.”

#### **Claim Objections**

1. Claim 12 has been amended as suggested by the Examiner.

#### **Claim Rejections – 35 USC S 103**

3. Claims 1, 6-8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yabuuchi (U.S. 5,945,267).

Applicants agree with the Examiner’s analysis that Yabuuchi teaches a silver halide color photographic light sensitive material comprising a support having thereon photographic component layers including a silver halide emulsion layer, at least one of the component layers containing a coupler of his invention. Applicants further agree that Yabuuchi teaches that the component layer containing the coupler preferably further contains a polymeric compound having a repeat unit represented of Formula (2) (col. 24, line 24-32), in which A and B each represent an ethylenic unsaturated compound which is copolymerizable.

The Examiner has further stated that “As one of the examples for the ethylenic unsaturated compound, Yabuuchi teaches N-(1,1-dimethyl-3-hydroxybutyl)methacrylate. Therefore, it would have been obvious to one of ordinary skill in the art to use the monomer of N-(1,1-dimethyl-3-hydroxybutyl)methacrylate to form the repeating unit of “A” in the formula shown above with a reasonable expectation of obtaining a silver halide photographic light sensitive material having high sensitivity and low fog and superior storage stability.”

Applicants respectfully disagree that Yabuuchi *teaches* “N-(1,1-dimethyl-3-hydroxybutyl)methacrylate.” There is no chemical compound known to Applicants which corresponds to “N-(1,1-dimethyl-3-hydroxybutyl)methacrylate.” The prefix “N-“ is commonly accepted nomenclature to indicate the presence of nitrogen or an N-containing substituent in the molecule being named. But there is no corresponding part in the name – “N-(1,1-dimethyl-3-hydroxybutyl)methacrylate” - to indicate what kind of N-containing substituent is meant. Since Yabuuchi does not supplement this description (i.e., the chemical name) with a chemical formula or structure, there is no way to discern whether Yabuuchi meant N-(1,1-dimethyl-3-hydroxybutyl)methacrylamide or some other compound. Since N-(1,1-dimethyl-3-hydroxybutyl)methacrylate doesn’t exist, it is neither accurate nor reasonable to assert that Yabuuchi *teaches* “N-(1,1-dimethyl-3-hydroxybutyl)methacrylate.”

Application No.: 10/669,492  
Docket No.: SR0021USNA

Since the Examiner has cited no other reference in the rejection of claims 1, 6-8 and 11, and all of the Examiner's arguments are predicated on the assumption that Yabuuchi's teachings are valid and complete and that "N-(1,1-dimethyl-3-hydroxybutyl)methacrylate" exists, Applicants believe that the rejection should be withdrawn.

Applicants respectfully request that claims 1, 6-8, and 11 be allowed.

#### Allowable Subject Matter

4. Claims 2-5, 9, 10, and 13 are objected to as being dependent upon a rejected base claim.

Applicants believe, as argued above, that the base claims are patentable, and therefore that claims 2-5, 9, 10, and 13 are in condition for allowance as written. Applicants respectfully request that claims 2-5, 9, 10, and 13 be allowed.

5. Claims 14-26 are allowed.

Applicants agree with the Examiner's analysis of the basis of patentability for these claims.

Application No.: 10/669,492  
Docket No.: SR0021USNA

In view of the foregoing, allowance of the above-referenced application is respectfully requested.

Respectfully submitted,



**Karin J. Karel**  
PATENT AGENT FOR APPLICANTS  
Registration No.: 33,918  
Telephone: (302) 695-4641  
Facsimile: (302) 695-2598

Dated: November 24, 2004